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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/665,332	09/17/2003	Peter Hamilton	10121/01705	5439
7590 08/15/2008 FAY KAPLUN & MARCIN, LLP Suite 702 150 Broadway New York, NY 10038				
EXAMINER RAMANA, ANURADHA				
ART UNIT		PAPER NUMBER		
3733				
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08/15/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/665,332

Applicant(s)

HAMILTON, PETER

Examiner

Anu Ramana

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 February 2008.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 29-35 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 29-35 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 17 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB-08)
Paper No(s)/Mail Date _____
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is being withdrawn.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 29-32 are rejected under 35 U.S.C. 102(b) as being anticipated by Cohen (US 5,336,252).

Cohen discloses a method of grasping a selected portion of tissue including the steps of: inserting a trocar or an insertion device 72 into a hole or a body cavity; advancing a substantially transparent flexible cup 92 through the device; visually positioning the cup adjacent a selected portion of tissue by observing the selected portion of tissue using an endoscope; and applying vacuum pressure or suction to the cup to cause the tissue to move from outside the cup to a position inside the interior of the cup (col. 10, lines 48-68 and col. 11, lines 1-40).

The method step of claim 30 is inherently performed when guiding catheter 74 is withdrawn through insertion device 72.

The method step of claim 31 is inherently performed when the guiding catheter 74 is maneuvered to grasp the pericardium.

Regarding claim 32, Cohen discloses all of the claimed method steps. It is noted that suction cup 92 cannot be disengaged from the pericardium, after completion of a procedure, unless a positive pressure is applied.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 29-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schneebaum et al. (US 5,423,830) in view of Cohen (US 5,336,252).

Schneebaum et al. disclose a method of grasping a selected portion of tissue from a surface of body cavity including: inserting an insertion device 60 into the body cavity; advancing a flexible cup 78 distally from a lumen of the insertion device; visually positioning the flexible cup adjacent a polyp or "selected portion of tissue" by using a fiber optic illumination guide and fiber optic image guide; and applying a vacuum to move the tissue from outside the cup to inside the cup (Figs. 5A-5C and col. 6, lines 5-55).

Regarding claims 30 and 31, these steps are inherently performed when the Schneebaum et al. device is used to extract a polyp.

Regarding claims 33 and 34, Schneebaum et al. disclose fastening portions of tissue around a periphery of the polyp using a snare followed by severing the polyp from the surrounding tissue.

Regarding claims 29-34, Schneebaum et al. disclose all elements of the claimed invention except for the cup being made of a transparent material.

Cohen teaches a suction cup made of a transparent material so that underlying tissue can be viewed through the cup (col. 11, lines 18-21).

Therefore, it would have been recognized by one of ordinary skill in the art at the time the invention was made that applying the known technique of molding a suction cup from a transparent material, as taught by Cohen, to the Schneebaum et al. device would have yielded predictable results, i.e., a suction cup that enables viewing of underlying tissue.

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Claim 35 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schneebaum et al. (US 5,423,830) and Cohen (US 5,336,252), further in view of Wilk et al. (US 5,578,031).

The combination of Schneebaum et al. and Cohen discloses all elements of the claimed invention except for stapling to secure tissue.

It is well known that a surgical operation may include other steps such as stapling, as evidenced by Wilk et al. (col. 4, lines 8-10).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have utilized an additional step such as a well known surgical technique for securing tissue such as stapling, to enable joining of severed tissue in the vicinity of the polyp being removed.

Response to Arguments

Applicant's arguments submitted under "REMARKS" in the response filed on February 25, 2008 have been considered but are moot in view of the new ground(s) of rejection.

Allowable Subject Matter

The indicated allowability of claims 32 and 35 is withdrawn in view of the new rejections made in this action. The Examiner sincerely apologizes for any inconvenience caused to the Applicants by this action.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anu Ramana whose telephone number is (571) 272-4718. The examiner can normally be reached Monday through Friday between 8:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached at (571) 272-4719. The

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fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AR

August 12, 2008

/Anu Ramana/
Primary Examiner, Art Unit 3733